



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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AUG 12 2002

In re

:  
:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 CFR 10.7(c)  
:

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading his-her answers to questions 18 and 21 of the morning section and questions 4, 6, 10, 32, and 48 of the afternoon section of the Registration Examination held on October 17, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 69. On January 31, 2002 petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

### **OPINION**

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner.

The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct

answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has not been granted any additional points on the Examination. No credit has been awarded for morning questions 18 and 21 and afternoon questions 4, 6, 10, 32 and 48. Petitioner's arguments for these questions are addressed individually below.

Morning question 18 reads as follows:

18. Which of the following is in accord with proper USPTO practice and procedure?

(A) Satisfaction of the enablement requirement of the first paragraph of 35 U.S.C. § 112 by the disclosure in a specification also satisfies the written description requirement of the second paragraph of 35 U.S.C. § 112.

(B) A claim to a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a process eligible for patent protection.

(C) A claim for a machine can encompass only one machine, such as a single computer, for performing the underlying process.

(D) A claim that recites nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are statutory natural phenomena.

(E) A composition of matter is a single substance, as opposed to two or more substances, whether it be a gas, fluid, or solid.

The model answer is selection (B).

MPEP § 2106 (IV)(B)(2)(b)(ii) (Computer Related Process ...), "If the 'acts' of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. Thus, a claim to a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process." (A) is not correct. MPEP § 2106 (V)(B)(1), and see *In re Barker*, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), *cert. denied*, *Barker v. Parker*, 434 U.S. 1064 (1978) (a specification may be sufficient to enable one skilled in the art to make and use the invention, but still fail to comply with the written description requirement). See also *In re DiLeone*, 436 F.2d 1404, 1405, 168 USPQ 592, 593 (CCPA 1971). Also, the written description requirement is in the first paragraph, not the second paragraph, of 35 U.S.C. § 112. (C) is not correct. MPEP § 2106 (IV)(B)(2)(a) (Statutory Product Claims). (D) is not correct. MPEP § 2106 (IV)(B)(1)(c) (Natural Phenomena Such As Electricity or Magnetism), and see *O'Reilly v. Morse*, 56 U.S. (15 How.) at 112 - 114. (E) is incorrect. MPEP § 2106 (IV)(B)(2) (Statutory Subject Matter), and see *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 197 (1980); and *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), *aff'd per curiam*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958).

Petitioner argues that answer choice (C) is a correct answer and that answer (B) may not be in accord with proper USPTO practice and procedure. Petitioner argues that it is true that one machine is sufficient to provide patentable subject matter. Moreover, petitioner argues that answer (B) does not exist in the section of the MPEP referenced.

Petitioner's arguments have been considered but are not deemed persuasive. Petitioner has misinterpreted the claim language of answer choice (C). Answer choice (C) asks whether or not a claim to a machine is limited to one machine. The correct answer is that a claim to a machine may be comprised of more than one machine. See MPEP § 2106 (IV)(B)(2)(a) (Statutory Product Claims). A machine is a concrete thing consisting of parts or of certain devices and combinations of devices. See *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863). Accordingly, answer choice (C) is not correct. Moreover, the correct of answer (B) is shown in MPEP § 2106(B)(2)(b)(ii), which states that a process that merely manipulates a purely mathematical algorithm is nonstatutory despite the fact that it might inherently have some usefulness.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 21 reads as follows:

21. An inventor, working with prior art subject matter, changes the subject matter, and thereafter files a patent application only claiming the changed subject matter. Which of the following changes might render the claimed subject matter patentable?

(A) Where the only difference between the prior art device and the claim device was a recitation of relative dimensions of the claimed device and the claimed device would not perform differently than the prior art device.

(B) Where the only difference between the prior art device and the claimed device is the configuration of the claimed device, and the configuration is a matter of choice without significance regarding the use of the device.

(C) Where the difference between the prior art, an impure material, and the claimed subject matter, the purified form of the impure material, is the purity of the material and the utility of the purified material, which differs from the impure material.

(D) Where the only difference between the prior art device and the claimed device is a reversal of the parts that move relative to each other, and without any unexpected results.

(E) Where the only difference between the prior art device and the claimed device is elimination of an element and its function, and elimination of the function was desired, required, or expected.

The model answer is selection (C).

MPEP § 2144.04(VII), citing *In re Bergstrom*, 427 F.2d 1394, 166 USPQ 256 (CCPA 1970). (A) is not correct. MPEP § 2144.04(IV)(A), citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). (B) is not correct. MPEP § 2144.04(IV)(B) citing *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). (D) is not correct. MPEP § 2144.04(VI)(A), citing *In re Gazda*, 219 F.2d 449, 104 USPQ 400 (CCPA 1955). (E) is not correct. MPEP § 2144.04(II)(A), citing *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975); and *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989).

Petitioner argues that all of the answers are correct and therefore petitioner's answer choice (E) is correct. Petitioner argues that the elimination of the device might make the claim easier or cheaper to assemble. Petitioner further argues that by eliminating a device, it is possible that the claimed device no longer "reads on" the prior art device.

Petitioner's arguments have been considered but are not deemed persuasive. Petitioner assumes additional facts that are not presented in the question. The directions on the first page of the textbook caution petitioner against making assumptions that do not exist in the fact pattern presented. Nothing in the question discusses making the device easier or

cheaper to assemble. Moreover, applicants argument that eliminating a device possibly would make the device no longer “read on” the prior art device would not address whether the application would still be rendered obvious and therefore unpatentable. See MPEP § 2144.04(II)(A). The Board has established that an omission of an element and its function is obvious if the function of the element is not desired. See *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter 1989). Accordingly, petitioner’s answer choice (E) is not a correct answer.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 4 reads as follows:

4. In 1996, Sydney, while vacationing at the North Pole, invents a new method of ice fishing using a solar powered fishhook with a transmission device for indicating the presence of a fish. For 5 years, Sydney practiced his invention exclusively at the North Pole, outside of the United States, its possessions, or its territories or any WTO or NAFTA country. He showed his invention to only one person, his friend Charlie, while Charlie was visiting him at the North Pole in June 2001. Charlie spoke to no one in the United States about the idea and crafted a near duplicate and began to publicly use it upon his return to Wisconsin in September 2001. On October 18, 2001, Sydney telephones you and complains to you that Charlie, the only person who has ever seen Sydney’s device, has begun using his device. In the October 18, 2001 phone conversation, Sydney asks you for advice as to the filing of a patent application. Which of the following is the best advice for Sydney?

(A) The witnessing of the fishhook by Charlie in June 2001 constitutes knowledge of the invention, and claims directed to Sydney’s invention could be properly rejected under 35 U.S.C. §102(a).

(B) Use of the device in Wisconsin constitutes public use and since Sydney cannot establish prior invention through activities at the North Pole, he is precluded from antedating the date of the first public use in the United States.

(C) Since Sydney invented the fishing device in 1996, he is the prior inventor and can overcome the first date of public use by Charlie by filing a 37 CFR1.131 affidavit or declaration.

(D) Since Charlie first used the fishing device in the United States, Charlie may file a patent application.

(E) Since Charlie’s public use in Wisconsin was not authorized, Sydney may still file a patent application on the fishing device.

The model answer is selection (B).

Sydney is precluded from filing for a patent because of Charlie's recent public use in Wisconsin. A declaration or affidavit under 37 CFR 1.131 is not permissible since the use at the North Pole did not occur in a NAFTA or WTO country. Answer (A) is not correct as the knowledge did not occur in the United States and was not public knowledge. Answer (C) is not correct because of the reasoning stated in (B). Answer (D) is not correct since Charlie was not the inventor. Answer (E) is not correct since public use in the United States by a third party may establish a date for prior art purposes. 35 U.S.C. § 102(a).

Petitioner argues that there is no correct answer and therefore petitioner's answer choice (C) should be given credit. Petitioner argues that answer (B) is not the best advice because the use was less than a year before the U.S. filing date and therefore 35 USC 102(b) is unavailable. Petitioner is correct that 35 USC §102(b) is not applicable. However, the activity is properly rejected under 35 USC § 102(a). 35 USC § 102(a) states that **"A person shall be entitled to a patent unless (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent...."** Moreover, Sydney could not file a declaration or affidavit under 37 CFR 1.131 because all of Sydney's activity occurred at the North Pole, a non NAFTA or WTO country. Therefore, the best advice would be answer (B) as asserted by the Office.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 6 reads as follows:

6. An examiner has advanced a reasonable basis for questioning the adequacy of the enabling disclosure in the specification of your client's patent application, and has properly rejected all the claims in the application. The claims in the application are drawn to a computer program system. In accordance with proper USPTO practice and procedure, the rejection should be overcome by submitting \_\_\_\_\_

(A) factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone.

(B) arguments by you (counsel) alone, inasmuch as they can take the place of evidence in the record.

(C) an affidavit under 37 CFR 1.132 by an affiant, who is more than a routineer in the art, submitting few facts to support his conclusions on the ultimate legal question of sufficiency, i.e., that the system "could be constructed."

(D) opinion evidence directed to the ultimate legal issue of enablement.

(E) patents to show the state of the art for purposes of enablement where these patents have an issue date later than the effective filing date of the application under consideration.

The model answer is selection (A).

MPEP § 2106.02 (Affidavit Practice (37 CFR 1.132)). Factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone can rebut a prima facie case of nonenablement. See *Hirschfield v. Banner*, Commissioner of Patents and Trademarks, 200 USPQ 276, 281 (D.D.C. 1978). (B) is not correct. MPEP § 2106.02 (Arguments of Counsel), and see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); *In re Schulze*, 145 USPQ 716 (CCPA 1965); and *In re Cole*, 140 USPQ 230 (CCPA 1964). (C) is not correct. MPEP § 2106.02 (Affidavit Practice (37 CFR 1.132)), and see *In re Brandstadter*, 179 USPQ 286 (CCPA 1973). (D) is not correct. MPEP § 2106.02 (Affidavit Practice (37 CFR 1.132)), and see *Hirschfield v. Banner*, Commissioner of Patents and Trademarks, 200 USPQ 276, 281 (D.D.C. 1978). (E) is not correct. MPEP § 2106.02, (Referencing Prior Art Documents), and see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); and *In re Gunn*, 190 USPQ 402, 406 (CCPA 1976).

Petitioner argues that answer (C) is correct because it meets the requirements of the question by providing a means of overcoming the rejection. Petitioner argues that the declaration must be considered. However, petitioner's arguments are inconsistent with MPEP § 2106.02 (Affidavit practice 37 CFR 1.132). MPEP § 2106.02 states that when an affiant's skill level is higher than that required by a routineer in the art, the affidavit would not be probative as to the amount of experimentation required by a routineer in the art to implement the invention. An affiant who is more than a routineer in the art would require less experimentation to implement the claimed invention rather than that for the routineer. Because the examiner would not find such affidavit probative, the rejection would not be overcome with the filing of the affidavit. Accordingly, petitioner's answer choice (C) is not a correct answer.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 10 reads as follows:

10. Harriet filed a nonprovisional patent application in the USPTO containing a written assertion of small entity status. Based upon proper USPTO practice and procedure, which of the following statements is correct?

(A) If Harriet files a related, continuing application wherein small entity status is appropriate and desired, it will not be necessary to specifically establish assertion of such status in the continuing application.

(B) If Harriet files a related, reissue application wherein small entity status is appropriate and desired, it will be necessary to specifically establish assertion of such status in the reissue application.



(C) If Harriet files a related, divisional application under 37 CFR 1.53, wherein small entity status is appropriate and desired, it will not be necessary to specifically establish assertion of such status in the divisional application.

(D) If Harriet refiles her application as a continued prosecution application under 37 CFR 1.53(d), wherein small entity status is appropriate and desired, it will not be necessary to specifically establish assertion of such status in the continued prosecution application.

(E) If Harriet subsequently assigns her rights to another party for whom small entity status is appropriate and desired, it will be necessary to specifically re-establish assertion of such status.

The model answer is selection (B).

(B) is correct and (A), (C) and (D) are wrong. 37 CFR 1.27(c)(4) (“The refiling of an application under § 1.53 as a continuation, divisional, or continuation-in-part application, including a continued prosecution application under § 1.53(d), or the filing of a reissue application, requires a new assertion as to continued entitlement to small entity status for the continuing or reissue application.”). (E) is also wrong. 37 CFR 1.27(e)(1) (“Where an assignment of rights...to other parties who are small entities occurs subsequent to an assertion of small entity status, a second assertion is not required.”)

Petitioner appears to be arguing that B is flawed because it incorporates the phrase “specifically” which is not necessary to make an assertion of small entity status. Accordingly, petitioner argues that answer (B) is not correct. Petitioner arguments have been considered but such are not deemed persuasive. 37 CFR 1.27 (c)(4) states that status as a small entity must be **specifically** established by an assertion in each related, continuing and reissue application in which status is appropriate and desired. (emphasis added). Accordingly, the language of answer choice (B) mirrors the regulatory language. Answer (B) is proper USPTO practice and procedure and is a correct answer.

Petitioner has the burden of showing that his answer choice is correct. Answer (D) is clearly not correct. As noted in 37 CFR 1.27(c)(4), filing a continued prosecution application under 37 CFR 1.53(d) requires a new assertion as to continued entitlement to small entity status for the continuing or reissued application.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 32 reads as follows:

32. Which of the following is true?

(A) Once the issue fee has become due, provided an original application has not been pending more than three years, the applicant may request and the Office may grant a request for deferral of payment of the issue fee.

(B) The time period set for the payment of the issue fee is statutory and cannot be extended. However, if payment is not timely made and the delay in making the payment is shown to be unavoidable, upon payment of a fee for delayed payment, it may be accepted as though no abandonment had occurred, but there will be a reduction on the patent term adjustment for the period of abandonment.

(C) Upon written request, a person citing patents and printed publications to the Office that the person believes has a bearing on the patentability of a particular patent, may request that his or her name remain confidential.

(D) To obtain benefit of priority based on an earlier filed patent application, an applicant in a later filed continuation application is not required to claim priority under 35 U.S.C. § 120 to an earlier filed application.

(E) Each of statements (B) and (C) is true.

The model answer is selection (E).

As to (B), see 35 U.S.C. §§ 151; 154(b)(2)(ii) and (iii); 37 CFR 1.704(c)(3); MPEP § 1306. As to (C) see MPEP §§ 2203 and 2212. As to (D), the claim for priority is not required, as a person may not wish to do so in order to increase the term of his or her patent. As to (A) deferral under 37 CFR 1.103 is not available following the notice of allowance. Since (B) and (C) are correct, (E) is the best answer.

Petitioner argues that the correct answer is (C) and that answer (E) is not the correct answer because answer (B) is incomplete. Petitioner argues that (B) is an incorrect answer because answer (B) does not mention the requirement of the petition or petition fee in the as mentioned in MPEP § 711.03(c).

Petitioner's arguments have been fully considered, but are not persuasive. The facts presented in the answer (B) show that the petition is made by the statement "the delay in making the payment is **shown** to be unavoidable" (emphasis added). The only method consistent with USPTO practice and procedure to make a showing is to file a written statement of facts to support the assertion that the delay was unavoidable. In addition, the petition fee was supplied by the statement "upon payment of a fee for delayed payment." Therefore, since all the necessary requirements of 37 CFR 1.137(a) were met in answer (B), the answer is correct. Accordingly, the correct answer to the question is (E) because it includes answers (B) and (C).

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 48 reads as follows:

48. Your longstanding client, Acme Chemical, comes to you for advice concerning a competitor's patent that Acme fears might cover Acme's key commercial product. Acme

informs you that it began selling its product approximately eleven months before the competitor filed its patent application, and that a complete description of the product and how to make it was published in a trade magazine approximately ten months before the competitor's December 8, 1999 application filing date. Acme asks you to recommend options short of litigation that might be available to challenge validity of the patent. Acme also asks that in making your recommendation you take into account that Acme will not challenge the patent's validity unless it can be actively involved in all phases of the proceeding, even if that involvement will increase Acme's costs. Which of the following is the most reasonable advice to Acme?

- (A) You suggest that Acme request *ex parte* reexamination on the basis of the trade magazine publication and that Acme file a reply to any statement by the patent owner concerning any new question of patentability.
- (B) You suggest that Acme request *ex parte* reexamination on the basis of Acme's prior sales and the trade magazine publication.
- (C) You suggest that Acme request *inter partes* reexamination on the basis of the trade magazine publication only.
- (D) You suggest that Acme request *inter partes* reexamination on the basis of Acme's prior sales and the trade magazine publication.
- (E) You suggest that Acme inform the competitor in writing of the prior sales and trade magazine publication to force the competitor to inform the USPTO of this information and to force the competitor to initiate a reexamination of its own patent.

The model answer is selection (C).

Answers (B) and (D) are unreasonable advice at least because reexamination is available only on the basis of prior art patents or publications. See, e.g., 37 CFR 1.510, 1.552, 1.906 and 1.915. A request for reexamination may not properly rely upon evidence of public use or sales. Answer (A) is less reasonable than (C) at least because Acme will have the opportunity to submit a reply only if the patent owner chooses to file a statement under 37 CFR 1.530. 37 CFR 1.535. Any further proceedings would be completely *ex parte*. Acme has made it clear that it wants to participate in the proceedings. Answer (E) is less reasonable than (C) because a patent owner is not obliged to cite prior art to the USPTO in an issued patent. Also, the competitor would not be required to request reexamination. Indeed, the competitor would not be able to request reexamination unless the competitor had a good faith belief that the trade magazine article raised a substantial new question of patentability.

Petitioner argues the question is flawed because prior art events are not necessarily prior art because the events are not 35 USC §102(b) events and may not be § 102(a) events depending upon the date of the invention. Petitioner further asserts that it might also be critical to know the invention date of Acme to judge the possibility of a §102(g) rejection.

Moreover, petitioner argues that the question is not a proper question because it is beyond the possible scope exam and requires legal advice.

Petitioner's arguments have been considered but are not deemed persuasive. First, the question involves issues of patent prosecution that is not beyond the scope of permissible subject matter. Accordingly, the question is an appropriate test question. Moreover, petitioner has failed to show why his answer choice (B) is the best choice. The burden is on the petitioner to show that answer (B) is the best choice. Under any circumstances choice (B) would not be most reasonable advice to give Acme. Answer choice (B) says that you should suggest *ex parte* reexamination on the basis of prior sales and the trade magazine article. Answer (B) is unreasonable advice at least because reexamination is available only on the basis of prior art patents or publications. See, e.g., 37 CFR 1.510, 1.552, 1.906 and 1.915. Moreover, the fact pattern says that Acme wants to be actively involved in all phases of the proceedings. However, Acme's active participation in *ex parte* reexamination will end prior to the conclusion of the reexamination. See 37 CFR 1.550(g). Accordingly, *inter partes* reexamination will allow more active participation by Acme and would be a more reasonable answer.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

**ORDER**

For the reasons given above, zero points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is positioned above the printed name and title.

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Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy